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Paper No. 5

LAHIVE & COCKFIELD
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DEC 3 1 2001

OFFICE OF PETITIONS

In re Application of :
Kenneth Lerman :
Application No. 09/872,326 : DECISION REFUSING STATUS
Filed: 1 June, 2001 : UNDER 37 CFR 1.47(b)
Attorney Docket No. SYCS-038/P89 :

This is in response to the petition under 37 CFR 1.47(b) filed on 28 September, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 1 June, 2001, without an executed oath or declaration.

Accordingly, on 30 July, 2001, a "Notice To File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 28 September, 2001, the present petition and petition fee were filed, accompanied by, *inter alia*, a declaration naming Kenneth Lerman as the sole inventor and signed by Ke Le on behalf of the non-signing inventor, an employment agreement between inventor Lerman and Sycamore Networks, Inc., and a declaration by Ke Le, Technology Officer for Sycamore Networks, Inc. Petitioners also provided a copy of an employment agreement between Lerman and Sycamore Networks, Inc., which states that Lerman agrees to assign to Sycamore all inventions during the period of employment (i) which relate at the time of conception or reduction to the practice of the Invention to the Company's business or actual or demonstrably anticipated research or development, or (ii) which were developed on any amount of the Company's equipment, supplies, facilities or trade secret information, or (iii) which resulted from any work Lerman performed for the Company, whether or not performed during business hours.

Petitioners state that a copy of the application papers were sent to Lerman, but that he refused, via email and telephone, to sign the declaration.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and

(6) proof of irreparable damage.

The petition lacks items (1), (2), and (6).

In regards to item (1), the declaration of Ke Le states that attorney Michael Reardon spoke with Lerman by phone, and that Lerman orally refused to sign the declaration. As an oral refusal must be proven by a statement from a person with first hand knowledge, Attorney Reardon must provide details of the oral refusal in an affidavit or declaration of facts.

In regards to item (2), the declaration is insufficient in that it has not been signed by a corporate officer (president, vice

president, treasurer, or secretary) of the Rule 47(b) applicant. If the declaration is not signed by a corporate officer, then proof of authority of the person signing on behalf of the corporation must be submitted in accordance with MPEP 409.03(b). The officer must identify his or her title in the declaration, and the officer's mailing address, residence, and citizenship must also be provided in the declaration. Attention is directed to 37 CFR 1.63(a)(3); MPEP §§ 605.02, 605.03. Additionally, the application number is miscaptioned on the declaration submitted with the present petition.¹ An oath or declaration in compliance with 37 CFR 1.63 and 1.64, properly identifying the application by application number and filing date, is required.²

In regards to item (6), petitioners must establish irreparable damages in accordance with MPEP 409.03(g).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.



Douglas I. Wood
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Office of the Deputy Commissioner
for Patent Examination Policy

¹The application number is listed as 09/872,236 rather than 09/872,326.

²See MPEP 409.03(b).